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10/082,398	02/25/2002	Salim G. Kara	61135/P004CP1CP1C2/101074	5850

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DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
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EXAMINER

COSIMANO, EDWARD R

ART UNIT	PAPER NUMBER
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3639

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/082,398

Applicant(s)

KARA, SALIM G.

Examiner

Edward R. Cosimano

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 June 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,4-16,19-25 and 27-36.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☒ Other: PTO-892.

Edward R. Cosimano
Primary Examiner
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1. Applicant's claim for the benefit of an earlier filing data under 35 U.S.C. § 120 is acknowledged.

2. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the continuing data in paragraph number 1 on page 1 in reference to application 09/491,949,

with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

Appropriate correction is required.

3. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.52, 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(b-f).

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

4.1 Claims 1, 6-16, 21-25 & 27-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schuessler (2,964,323) in view of replacing a manual activity with automatic activity, In re Venner and Bowser, 120 U.S.P.Q. 192 @ 194 (CCPA, 1958).

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4.1.1 In regard to the following rejection:

A) it is noted that as would be clearly understood by one of ordinary skill at the time of the invention, both a postage indicia and a cancelled postage stamp provide the same function, that is they each provide proof of the payment of an amount of postage, it would have been obvious to one of ordinary skill that these items are in fact equivalent representations of the same thing.

4.1.2 In regard to claims 1, 6-16, 21-25 & 27-36, Schuessler ('323) discloses envelope 31 with a front surface that contains three windows 33, 34 & 35, that are covered with glassine, that is cellophane 36, where cellophane 36 protects the contents 10 of envelope 31 while permitting the underlying portions of contents 10 to be viewed from the outside of envelope 31. It is further noted that covered windows 33, 34 & 35 are positioned on the front of envelope 31 such that when:

- A) sender/return address 16,27;
- B) addressee/recipient address 15,26; and
- C) postmark 17,30;

which have been printed as part of contents 10 so that when contents 10 has been properly folded and inserted into envelope 31, then the addressee/recipient address 15,26 is clearly viewable through covered window 33 in the lower left portion of envelope 31; the sender/return address 16,27 is clearly viewable through covered window 34 in the upper left portion of envelope 31; and the postmark 17,30 is clearly viewable through covered window 35 in the upper right portion of envelope 31.

4.1.3 In regard to using a computer to generated the postage and contents at the same time, Schuessler ('323) does not disclose the use of a computer to create and generate the contents of the envelope. However, Schuessler ('323) does suggest that:

- A) it is desirable to reduce the time required to complete forms to make this process more efficient; and
- B) the information that is to be placed in specified locations on the contents of the envelope is performed manually by the user.

Since it is well known that the use of a computer to complete and generate various forms speeds up the processing of the forms as a whole, it would have been obvious to one of ordinary skill at

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the time of the invention that the manual completion of contents 10 of the envelope 31 by the user of Schuessler ('323) could be automatically performed by a computer system in order to save time and make the process more efficient.

4.2 Claims 4, 5, 19 & 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Schuessler (2,964,323) in view of In re Venner and Bowser, 120 U.S.P.Q. 192 @ 194 (CCPA, 1958) as applied above to claims 1, 6-16, 21-25 & 27-35, and further in view of either Gunn (GB 1380590) or Sansone et al (4,724,718) or Gilham (EP 0331352).

4.2.1 In regard to claims 4, 5, 19 & 20, Schuessler ('323) does not disclose that the postmark 17,30 includes a machine readable portion (claims 4 & 19) or that the machine readable portion (claims 5 & 20). However, it was known in 1975 as indicated by figs. 1, 2 & 3 of Gunn ('590); or it was known 1988 as indicated by figs. 2 & 3 of Sansone et al ('718); or it was known in 1989 as indicated by fig. 1 of Gilham ('352) that a postmark may contain both human readable and machine readable portions which are user for sorting mail and verification of the postage paid and the postmark. Further as taught by these references the machine readable portion may comprise a series of dots, as indicated by figs. 1, 2 & 3 of Gunn ('590) or a suitable barcode as indicated by figs. 2 & 3 of Sansone et al ('718) and by fig. 1 of Gilham ('352). Since, as taught by either Gunn ('590) or Sansone et al ('718) or Gilham ('352) it is well known that a postmark may comprise machine readable portions in the form a plain text and encrypted information in the nature of a suitable barcode, it would have been obvious to one of ordinary skill at the time of the invention that the postmark of Schuessler ('323) could contain machine readable portions in the nature of a suitable barcode so as to aid the Postal authority in sorting mail and verifying the postage paid and postmarks on the mail.

5. Response to applicant's arguments.

5.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

5.2 In regard to the alleged premature final rejection in section III of applicant's remarks, it is noted that record in the instant case clearly indicates that:

A) in a non final Office action mailed 10 July 2002 claims 1-36 as filed 25 February 2002 were rejected under 35 U.S.C. § 102(b) in view of Mercur (3,221,980) and 35 U.S.C. § 102(e) in view of Daumann (DE 4409386);

B) in the second Office action mailed 28 January 2003, claims 1-36 as filed 25 February 2002 were not rejected based on the prior art, since it was determined at that time that each of the independent claims 1, 16, 25 & 36 recited subject matter that would distinguish the pending claims over the prior art.

C) due to the subsequent discovery of pertinent prior art, in a third non-final Office action mailed 20 October 2004:

(1) claims 1, 2, 6-16, 21-25 & 27-35 as filed 25 February 2002 were rejected under 35 U.S.C. § 102(b) in view of Schuessler (2,964,323);

(2) claims 3, 17, 18, 26 & 36 as filed 25 February 2002 were rejected under 35 U.S.C. § 103 in view of Schuessler (2,964,323) in view of replacing a manual activity with an automatic activity that accomplishes the same result, (In re Venner and Bowser, 120 U.S.P.Q. 192 @ 194 (CCPA, 1958)); and

(3) claims 4, 5, 19 & 20 as filed 25 February 2002 were rejected under 35 U.S.C. § 103 in view of Schuessler (2,964,323) in view of replacing a manual activity with an automatic activity that accomplishes the same result, (In re Venner and Bowser, 120 U.S.P.Q. 192 @ 194 (CCPA, 1958)) and further in view of either Gunn (GB 1380590) or Sansone et al (4,724,718) or Gilham (EP 0331352).

It is noted that all of the claims were rejected based on prior art.

D) in response to the Office action mailed 20 October 2004, applicant in an amendment filed 20 January 2005 amended claims 1, 16 & 25 to include subject matter from previously rejected and now cancelled claims 2,3, 17,18 & 26, respectively.

E) in a fourth and final Office action mailed on 25 April 2005, the examiner rejected the remaining pending claims, that is:

(1) claims 1, 6-16, 21-25 & 27-36 as amended on 20 October 2004 were rejected under 35 U.S.C. § 103 in view of Schuessler (2,964,323) in view of replacing a manual activity with an automatic activity that accomplishes the same result, (In re Venner and Bowser, 120 U.S.P.Q. 192 @ 194 (CCPA, 1958)); and

(2) claims 4, 5, 19 & 20 as filed 25 February 2002 were rejected under 35 U.S.C. § 103 in view of Schuessler (2,964,323) in view of replacing a manual

activity with an automatic activity that accomplishes the same result, (In re Venner and Bowser, 120 U.S.P.Q. 192 @ 194 (CCPA, 1958)) and further in view of either Gunn (GB 1380590) or Sansone et al (4,724,718) or Gilham (EP 0331352).

Hence it can be seen that applicant's amendment caused the examiner to shift from an anticipation rejection of claims 1, 16 & 25 to an obvious rejection of these claims. Therefore the final rejection was not premature.

5.3 In regard to the 35 U.S.C. § 103 rejection, since:

A) claims 1, 16, 25 & 36 is drawing to an article or a combination of articles that appear to be produced by a particular process and hence are deemed to be a manufacture or product by process claims. With is determination in mind, pursuant to MPEP § 2113 and MPEP § 2114, these claims must be distinguished over the prior art by the structure recited in the claims and not the function of the structure or the process that produced the article/manufacture, therefore, since the structure depicted in Schuessler (2,964,323) whether it is computer generated or not anticipates the claimed invention since the combination of an envelope and a document is still an envelope and a document regardless of how either the envelope or document may have been created, see MPEP § 2113.

B) in regard to the automation of an manual process, it is noted that as evidenced by: (1) IBM Technical Disclosure Bulletin: "Word Processor Having CONDITIONAL TEXT Printing for Mass Mailings", 01 November 1986, Vol. 29, No. 6, pp. 2387 – 2389; discloses in 1986 that a word processor systems may create mailing by conditionally merging/inserting selected elements of text into another document; and (2) Sansone et al (4,831,555) in 1989 discloses that a word processor system combined with a postage metering system may print postage indicia on either an envelope or on the document/mailling in a position that would be visible through a window in an envelope; and (3) either Cordery et al (5,628,249) or Harman et al (5,684,706) which disclose a document file containing both envelope and document data that is separated for printing and then rejoined into a single item of mail, one of ordinary skill in preparing mailings

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would have be able to automate a manual process of completing a form, inserting the completed form and then mailing the envelope and form when mailing is required.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (571) 272-6802. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (571) 272-6812. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-3600.

6.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (571) 273-6802.

6.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306 (after 15 July 2005 (571) 273-8300).

6.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

07/11/05



Edward R. Cosimano

Primary Examiner A.U. 3639